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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,791	03/04/2004	Yoshihiro Nakao	034100-002	5495

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EXAMINER

MARTINELL, JAMES

ART UNIT	PAPER NUMBER
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1634

DATE MAILED: 02/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/791,791

Applicant(s)

NAKAO ET AL.

Examiner

James Martinell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) 10-32 and 34-46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/19 & 9/1/04</u> . | 6) <input type="checkbox"/> Other: _____ |

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Claims 10-32 and 34-46 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on December 29, 2005.

The drawings are objected to because nucleic acid sequences appear in Figures 10 and 11 without identifying SEQ ID NOs. See MPEP 2422 and 37 CFR § 1.821(d). The identifying SEQ ID NOs may be added to the brief description of the drawings. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The disclosure is objected to because of the following informalities.

- (a) Nucleotide sequences appear in Table 8 (page 93) without identifying SEQ ID NOs. Thus, the application does not comply with the Sequence Rules (37 CFR §§ 1.821-1.825). See MPEP 2422 and 37 CFR § 1.821(d). In order for any response to be considered a complete response to this Office action, appropriate correction is required.
- (b) Table 4 on page 88 is illegible.

Appropriate correction is required.

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The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP §608.01. Embedded hyperlink and/or other form of browser-executable code appear in at least the following locations:

- (a) page 9, line 7;
- (b) page 30, lines 20, 25, and 28; and
- (c) page 66, line 19.

Claim 1 is objected to because of the following informalities: the recitation of "whole genome sequence of industrial yeast" should be changed to "whole genome sequence of an industrial yeast".

Appropriate correction is required.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-9 and 33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are vague, indefinite, and incomplete.

- (a) The term "improvement in flavor" in claim 1 is a relative term which renders the claim indefinite. The term "improvement in flavor" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.
- (b) Claim 1 is incomplete because the instant application does not describe or provide a whole genome sequence of any yeast.

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- (c) The recitation of "functional analysis is carried out" (claim 1) is vague, indefinite, and incomplete because this is not a positive process step.
- (d) The recitation of "DNA array is used" (claim 2) is vague, indefinite, and incomplete because this is not a positive process step.
- (e) The recitation of "DNA sequence having 10 to 30 nucleotides existing in an open reading frame of the whole genome sequence of an industrial yeast and not existing in the region other than the region of said 10 to 30 nucleotides sequence in the whole genome sequence" (claim 3) is vague, indefinite, and incomplete because the instant application does not disclose the whole genome sequence of any yeast. Thus, the metes and bounds of the claim are not clear.
- (f) The recitation of "DNA sequence having 10 to 30 nucleotides existing in a non-coding region of the whole genome sequence of an industrial yeast and not existing in the region other than the region of said 10 to 30 nucleotides sequence in the whole genome sequence" (claim 5) is vague, indefinite, and incomplete because the instant application does not disclose the whole genome sequence of any yeast. Thus, the metes and bounds of the claim are not clear.

Claims 1-9 and 33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The instant application requires the use of nucleic acids that are not adequately described in writing. In *Vas-Cath v Mahurkar*, 19 USPQ2d 1111 (Fed. Cir. 1991) the court stated, "applicant must also convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of *the invention*. The invention is, for purposes of the 'written description' inquiry, *whatever is now claimed*" (emphasis in the original) (*Vas-Cath* at page 1117). The instant application does not "clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is now claimed" (*Vas-Cath* at page 1116). In

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Fiers v. Sugano, 25 USPQ2d 1601 (Fed. Cir. 1993), the court also held that, "An adequate written description of a DNA requires more than a mere statement that it is part of the invention and reference a potential method for isolating it; what is required is a description of the DNA itself" (*Fiers v. Sugano*, page 1606). This view was reiterated in *Fiddes v. Baird*, USPQ2d 1481 (BPAI 1993) at page 1483, "If a conception of a DNA requires a specific definition, such as by structure, formula, chemical name, or physical properties, as we have held, then a description also requires that degree of specificity. . . . one cannot describe what one has not conceived." The court amplified this notion with respect to inventions claiming genetic material in *Regents of the University of California v. Eli Lilly*, 43 USPQ2d 1398 (Fed. Cir. 1997), stating at page 1406,

"In claims to genetic material, however, a generic statement such as 'vertebrate insulin cDNA' or 'mammalian insulin cDNA,' without more, is not an adequate written description of the genus because it does not distinguish the claimed genus from others, except by function. It does not specifically define any of the genes that fall within its definition. It does not define any structural features commonly possessed by members of the genus that distinguish them from others. One skilled in the art therefore cannot, as one can do with a fully described genus, visualize or recognize the identity of the members of the genus. . . . Accordingly, naming a type of material generally known to exist, in the absence of knowledge as to what that material consists of, is not a description of that material."

The nucleic acids mentioned in the claims are not described as structures, but are merely discussed as desirable end-points of a discovery process to be used in yet other processes.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re*

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Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 2, 8, and 9 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over either of claims 1-8 and 12 of copending Application No. 10/932,182 or claims 1-8 and 12 of copending Application No. 11/217,529. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in each of the copending applications describe the methods of the instant claims, but with the steps grouped differently within each of the applications.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Martinell whose telephone number is (571) 272-0719.

The examiner works a flexible schedule and can be reached by phone and voice mail. Alternatively, a request for a return telephone call may be e-mailed to james.martinell@uspto.gov. Since e-mail communications may not be secure, it is suggested that information in such requests be limited to name, phone number, and the best time to return the call.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones, can be reached on (571) 272-0745.

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OFFICIAL FAX NUMBER

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300. Any Official Communication to the USPTO should be faxed to this number.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.


James Martinell, Ph.D.
Primary Examiner
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2/18/04